

### **Remarks/Arguments**

Claims 16-25 are pending in this application, and are rejected in the final Office Action of September 21, 2006. No claim amendments are presented herein. However, a listing of all pending claims is included herein for the Examiner's convenience.

#### **Re: Patentability of Claims 18-21 under 35 U.S.C. § 112, Second Paragraph**

Claims 18-21 are rejected under 35 U.S.C. §112, second paragraph for allegedly employing improper "means-plus-function" claims. Applicants respectfully traverse this rejection for at least the following reasons.

On page 7 of the final Office Action dated September 21, 2006, the Examiner alleges:

"Upon reviewing applicant's original disclosure (i.e., specification, claims), it is the examiner's conclusion that the written description does not link or associate particular structure to the function recited in the means-plus-function claim limitations, and it is not clear based on the facts of the application that one skilled in the art would have known what structure or materials perform the function recited in a means-plus-function limitation."

As indicated above, the Examiner alleges that the means-plus-function limitations of claims 18-21 are improper since it is not clear that one skilled in the art would have known what structure performs the recited functions. Applicants respectfully disagree. With respect to the embodiment of FIG. 4, for example, Applicants note that the claimed "first means" for "receiving a first user input" (see claim 18) and "receiving a user command" (see claim 20) clearly corresponds to keyboard IR receiver module 312 (see page 17, lines 6-8 of specification). Also with respect to the embodiment of FIG. 4, Applicants note that the claimed "second means" which performs various processing functions clearly corresponds to ARM processor 315 (see page 21, line 6 to page 22, line 5 of specification), as suspected by the Examiner on pages 7-8 of the final Office Action dated September 21, 2006. In view of this clarification, Applicants submit that claims 18-21 are proper "means-plus-function" claims, and respectfully request withdrawal of the rejection.

**Re: Patentability of Claims 16-18, 20, 22 and 24 under 35 U.S.C. §103(a)**

Claims 16-18, 20, 22 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,850,218 issued to LaJoie et al. (hereinafter, "LaJoie"). Applicants respectfully traverse this rejection for at least the following reasons.

With respect to independent claims 16, 18 and 22, these claims include:

"receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording;

receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased;

determining whether said second program also appears on said first list responsive to said second user input; and

removing, automatically, said second program from said first list if said second program appears on said first list." (see claim 16),

"first means for receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording, and for receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased; and

second means for determining whether said second program also appears on said first list responsive to said second user input, and for automatically removing said second program from said first list if said second program appears on said first list" (see claim 18), and

"a receiver operative to receive a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording, and to receive a second user input selecting a second program for removal from a second list representing a list of programs purchased; and

a processor operative to determine whether said second program also appears on said first list responsive to said second user input, and to automatically remove said second program from said first list if said second program appears on said first list." (see claim 22)

As indicated above, independent claims 16, 18 and 22 define a method/apparatus in which a program is automatically removed from a list of programs

scheduled for recording in response to user removal of the program from a list of programs selected for purchase. Applicants maintain that LaJoie fails to render the foregoing subject matter of independent claims 16, 18 and 22 obvious under 35 U.S.C. §103(a).

On page 10 of the final Office Action, the Examiner admits that:

"LaJoie et al. does not specifically disclose determining whether said second program also appears on said first list responsive to said second user input and removing, automatically, said second program from said first list if said second program appears on said first list"

and further states:

"however, the examiner notes that if a program scheduled for purchasing and recording is canceled from the all timers list, it would be counterintuitive to list it with the VCR timers and PPV purchases in the general settings menu. LaJoie et al. specifically states that selecting the all timers setting causes the display of all active timers in the set-top terminal (col. 22, l. 47-56 & Fig. 14). Thus, in canceling a timer from the all timers setting, the program can no longer be scheduled for purchasing or recording. Removing a program scheduled for purchasing and recording from the all timers list, but not from the list of PPV purchases or VCR timers would cause the PPV purchases and VCR timers lists to present false information to the user. Therefore, it would have been obvious to . . . remove a scheduled event from a list in response to removing the event from a list of all scheduled events, in order to avoid confusing a user."

In response, Applicants note that the Examiner is applying the wrong legal standard for obviousness under 35 U.S.C. §103(a). In particular, the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification

obvious unless the prior art suggested the desirability of the modification."") and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, LaJoie fails to teach or suggest the desirability of the inventions defined by independent claims 16, 18 and 22. In fact, LaJoie fails to even recognize the specific problems that the Applicants have recognized and addressed by the inventions defined by independent claims 16, 18 and 22.

On page 2, lines 13-23 of Applicants' disclosure, they recognize problems associated with the lack of coordination between performing program purchases and program recordings. Page 2, lines 19-23 specifically state:

"... since there is no linkage between these two processes, a user who wants to cancel a program from the purchase process or the record process will have to basically perform the same task twice. This is time consuming and inefficient."

As indicated above, Applicants have recognized the problems associated with a user having to redundantly perform the same task twice by canceling both a program purchase and a program recording. Independent claims 16, 18 and 22 address the foregoing problems by automatically removing a program from a first list of programs scheduled for recording in response to user removal of the program from a second list of programs selected for purchase. As a result, the user is not required to perform the same task twice by removing the program from the first list of programs scheduled for recording. In contrast, LaJoie fails to even recognize the problem associated with a user having to perform the same task twice. As such, LaJoie clearly fails to teach or suggest the desirability of the technique for coordinating program purchases and recordings defined by independent claims 16, 18 and 22, as Federal Circuit law requires for a rejection under 35 U.S.C. §103(a).

Because of LaJoie's complete silence regarding the above-referenced problem, LaJoie's system likely suffers the same deficiencies pointed out above in the Applicants' disclosure. That is, a user of LaJoie's system may likely be required to perform the

same task twice by removing a program from the list of programs scheduled for recording after he/she removes it from the list of programs selected for purchase. In any event, LaJoie's failure to teach or suggest the desirability of the inventions defined by independent claims 16, 18 and 22 renders it insufficient as a matter of law to sustain an obviousness rejection under 35 U.S.C. §103(a).

Next, with respect to independent claims 17, 20 and 24, these claims include:

“removing, in response to a user command, said program from a first list of programs representing programs scheduled for recording;

determining, in response to said user command, whether said program is also a purchased program;

enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and

removing said program from a second list of programs representing purchased programs responsive to user selection of said option.” (see claim 17),

“first means for receiving a user command;

second means for removing said program from a first list of programs representing programs scheduled for recording responsive to said user command;

said second means determining whether said program is also a purchased program responsive to said user command, and enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and

wherein said program is removed from a second list of programs representing purchased programs responsive to user selection of said option.” (see claim 20), and

“a receiver operative to receive a user command;

a processor operative to remove said program from a first list of programs representing programs scheduled for recording responsive to said user command;

said processor being further operative to determine whether said program is also a purchased program responsive to said user command, and to enable an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and

wherein said program is removed from a second list of programs representing purchased programs responsive to user selection of said option.” (see claim 24)

As indicated above, independent claims 17, 20 and 24 define a method/apparatus in which an on screen display option is provided so that a user is afforded an opportunity to cancel the purchase of a program in response to canceling a scheduled recording of the program. Applicants maintain that LaJoie fails to render the foregoing subject matter of independent claims 17, 20 and 24 obvious under 35 U.S.C. §103(a).

On pages 10-11 of the final Office Action, the Examiner admits that:

"LaJoie et al. does not specifically disclose determining, in response to said user command, whether said program is also a purchased program; enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and removing said program from a second list of programs representing purchased programs"

and further states:

"however the examiner notes that if a program scheduled for purchasing and recording is canceled from the all timers list, it would be counterintuitive to list it with the VCR timers and PPV purchases in the general settings menu. LaJoie et al. specifically states that selecting the all timers setting causes the display of all active timers in the set-top terminal (col. 22, l. 47-56 & Fig. 14). In canceling a timer from the all timers setting, the program can no longer be scheduled for purchasing or recording and would no longer appear on any timer list. LaJoie et al. also suggests the use of conflicts checking features in verifying that there are no conflicts created by a modified setting (for example, when there are overlapping timers)(col. 21, l. 30-35). LaJoie et al. specifically provides the example of a warning screen that alerts the user when trying to record an IPPV program and provides the user with the option of purchasing the program or canceling the warning (col. 21, l. 42-49). LaJoie et al. further illustrates that programs can be selected for purchasing and viewing or purchasing and recording (indicated by REC and PPV or the timer icon and PPV)(Fig. 14). Since a program scheduled for purchasing and recording could also be scheduled for purchasing and viewing, it would have been obvious to . . . use a conflict checking feature to allow a user the options of either purchasing and viewing the program or canceling the program from all timers in order to provide a more user-friendly interface."

In response, Applicants again note that the Examiner is applying the wrong legal standard for obviousness under 35 U.S.C. §103(a). As previously indicated above, the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. LaJoie fails to teach or suggest such desirability. Also indicated above, Applicants' disclosure recognizes and addresses problems associated with the lack of coordination between performing program purchases and program recordings. Independent claims 17, 20 and 24 address these problems by providing an on screen display option so that a user is afforded an opportunity to cancel the purchase of a program in response to canceling a scheduled recording of the program. LaJoie fails to even recognize these problems and thereby fails to teach or suggest the desirability of the technique for coordinating program purchases and recordings defined by independent claims 17, 20 and 24, as Federal Circuit law requires for a rejection under 35 U.S.C. §103(a).

While LaJoie teaches the use of warning screens that alert users of overlapping timers and/or when they trying to record an IPPV program (see column 21, lines 30-49), it fails to teach or suggest the use of an on screen display option to give a user an opportunity to cancel the purchase of a program in response to canceling a scheduled recording of the program, as defined by claims 17, 20 and 24. Moreover, the Examiner's reference to the "conflict checking feature" of LaJoie is misplaced with respect to claims 17, 20 and 24 since the method defined by these claims would not necessarily create a conflict. In particular, a user may cancel the scheduled recording of a purchased program, but still want to purchase the program. As such, there is no inherent "conflict" when a user cancels the scheduled recording of a purchased program.

As described above, LaJoie's failure to teach or suggest the desirability of the technique for coordinating program purchases and recordings defined by independent claims 16-18, 20, 22 and 24 (as evidenced by its failure to even recognize the specific

problems addressed by the claimed inventions) renders it insufficient as a matter of law to sustain an obviousness rejection under 35 U.S.C. §103(a). Accordingly, Applicants respectfully request withdrawal of the rejection of claims 16-18, 20, 22 and 24.

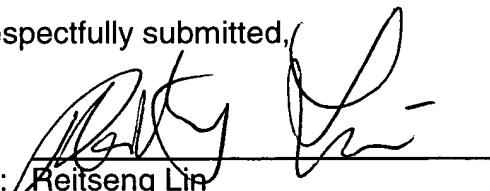
**Re: Patentability of Claims 19, 21, 23 and 25 under 35 U.S.C. §103(a)**

Claims 19, 21, 23 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over LaJoie in view of the RCA DRD202RA Owner's Manual (hereinafter, "the RCA manual"). Applicants respectfully traverse this rejection since the RCA manual is relied upon only for disclosing a "Buy and Record Option" and is unable to remedy the deficiencies of LaJoie pointed out above in conjunction with claims 16-18, 20, 22 and 24. Accordingly, Applicants respectfully request withdrawal of the rejection.

**Conclusion**

In view of the foregoing remarks/arguments, Applicants believe that this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicant's attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled. No fee is believed due. However, if a fee is due, please charge the fee to Deposit Account 07-0832.

Respectfully submitted,

By:   
Reitseng Lin  
Reg. No. 42,804  
Phone (609) 734-6813

Patent Operations  
Thomson Licensing Inc.  
P.O. Box 5312  
Princeton, New Jersey 08540  
November 17, 2006